

REMARKS

Claims 22 through 39 were presented for examination in the present application. The instant amendment cancels claims 23 through 25 without prejudice. Thus, claims 22 and 26 through 39 are pending upon entry of the instant amendment.

Claims 22-32 and 35-39 were rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,062,910 to Garcera et al (the Garcera '910 patent). Claims 33 and 34 were rejected under 35 U.S.C. §103(a) over the Garcera '910 patent in view of U.S. Patent No. 4,849,104 to Garcera et al (the Garcera '104 patent).

For purposes of clarity, claims 22 through 28 will be discussed later herein.

Independent claim 29 recites "at least one of said plurality of ceramic filter elements having a main part and at least one terminal region, said at least one terminal region having a smaller diameter than said main part, said smaller diameter being defined without restricting flow of the medium through said terminal region".

The Office Action asserts that the Garcera '910 patent discloses a ceramic filter element having a plurality of channels and ends smaller in outer dimension than the main body. As support for this assertion, the Office Action cites to the figures of the Garcera '910 patent and to col. 2, lines 5-10.

Applicants respectfully traverse the assertion that the figures of the Garcera '910 patent illustrate ends smaller in

outer dimension than the main body. Rather, Applicants assert that each figure of the Garcera '910 patent clearly show ends that are larger, not smaller, than the main body.

In addition, Applicants respectfully assert that col. 2, lines 5-10 of the Garcera '910 patent (hereinafter the asserted portion) does not contain an enabling disclosure sufficient to anticipate independent claim 29.

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

The asserted portion of the Garcera '910 patent states:

"Since the supports are made by extrusion, drying, and then sintering, their ends are irregular in shape because of the deformations to which they are subjected during extrusion and then sintering (bending under the effect of gravity, shrinkage at various stages, etc. . . .). It is therefore difficult to assemble such an element in an end plate while using a standard seal having a geometrically well-defined shape, e.g. an O-ring. The gap between the facing surfaces, i.e. the end of the support and the surface of the end plate, between which the seal is to be received varies too much from one position to another between these facing surfaces.

Attempts may be made to solve this problem by machining each end of the support so as to make it circularly symmetrical. However this has the effect of reducing the thickness of the "skin", i.e. the distance between the outer channels and the outside surface of the support." (emphasis added) See col. 1, line 61 through col. 2, line 10.

Thus, the Garcera '910 patent describes a problem associated with the prior art supports, namely that they are difficult to assemble in an end plate using a standard seal due to dimensional variation. Then, the asserted portion of the Garcera '910 patent provides a hypothetical solution to this problem by stating that "attempts may be made to solve this problem by machining each end of the support". However, the asserted portion of the Garcera '910 patent immediately dismisses this hypothetical solution as not being operable. Finally, the other parts of the Garcera '910 patent offers as its invention a support having larger ends, which is the antithesis of its hypothetical solution.

Yet, this non-working hypothetical solution of the Garcera '910 reference is cited by the Office Action as anticipating claim 29.

It is respectfully submitted that the hypothetical solution espoused by the asserted portion of the Garcera '910 reference is not sufficient to prove that the public was in possession of combination of claim 29. Specifically, it is respectfully submitted that the asserted portion of the Garcera '910 reference is non-enabling with respect to the elements of claim 29 and, thus, does not teach or suggest claim 29.

Therefore, claim 29, as well as claims 30 through 35 that depend therefrom, are believed to be in condition for allowance. Reconsideration and withdrawal of the rejection to these claims are respectfully requested.

Independent claim 36 now recites a first terminal region having a first outer dimension, a main part having a second outer dimension, where the second outer dimension is larger than said first outer dimension, and a foil reinforcing the first terminal region.

Notwithstanding Applicants belief that the asserted portion of the Garcera '910 patent is non-enabling, it is respectfully submitted that the Garcera '910 patent does not disclose a terminal region that is smaller than the main body and which also includes a foil reinforcing the terminal region as now recited by claim 36.

Rather, the cited portion of the Garcera '910 patent merely hypothesizes that attempts may be made to machine each end of the support. Further, the cited portion of the Garcera '910 patent acknowledges that this hypothetical solution is non-operative as it reduces the thickness of the "skin", i.e. the distance between the outer channels and the outside surface of the support.

Advantageously, claim 36 reinforces its terminal region with a skin to overcome the deficiencies noted by, but not resolved by, the cited portion of the Garcera '910 patent. Accordingly, it is submitted that the asserted portion of the Garcera '910 patent does not suggest reinforcing the smaller

terminal end with a foil as now recited by claim 36.

As such, claim 36, as well as claims 37 through 39 that depend therefrom, are believed to now be in condition for allowance.

Independent claim 22 has been amended to include the elements of claims 23 through 25. Thus, claim 22 now recites at least one terminal region that has a smaller diameter than the main part and "a shoulder defined by said main part and said at least one terminal region, said shoulder having the ability to take up an axial thrust force that acts upon the ceramic filter element".

Again, notwithstanding Applicants belief that the asserted portion of the Garcera '910 patent is non-enabling, it is respectfully submitted that the Garcera '910 patent does not disclose the terminal region having a smaller diameter than the main part and a shoulder having the ability to take up an axial thrust force as recited by claim 22.

Again, the cited portion of the Garcera '910 patent merely hypothesizes that attempts may be made to machine each end of the support. While other portions of the Garcera '910 patent may disclose a shoulder defined by larger ends for taking up axial thrust, the asserted portion of the Garcera '910 patent clearly does not suggest the shoulder defined by the main part and the at least one terminal region, which has the ability to take up an axial thrust force, as now recited by claim 22.

In light of the above, claim 22, and claims 26 through 28

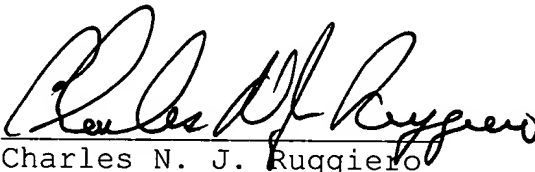
that depend therefrom, are believed to be in condition for allowance.

For at least the reasons set forth above, it is respectfully submitted that the present application is in condition for allowance. Such action is most earnestly solicited.

If for any reason the Examiner feels that consultation with Applicants' attorney would be helpful in the advancement of the prosecution, the Examiner is invited to call the undersigned attorney at the telephone number below for an interview.

Respectfully submitted,

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